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EXAMINER	
WEINHARDT, R	
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DATE MAILED: 06/26/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 4/10/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~0~~ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 14-24, 26-29, 33-34, 118-133 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-13, 25, 30-32 AND 35-117 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 14-24, 26-29, 33-34, 118-133 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

recognize returns of cassettes and to recognize new inventory when restocked. The so-called identification means in Bradt et al largely relates to cassette returns and not to previewing of products. Bradt et al. has a very oblique disclosure of the preview mode, and from the best that can be told from the specification, "preview" refers to a listing of titles available for sale or rent, and does not relate to actually previewing the *contents* of a music product. Thus, Riddell et al.'s nonenabling disclosure of a preview combined with Bradt et al.'s disclosure of previewing, involving only titles available for rent or sale, completely different than previewing as contemplated by the current invention, does not represent a meaningful combination.

Again, to cure the admitted defects of both Riddell et al. and Bradt et al., the Examiner cites Stern et al. to fill in the deficiencies. However, this combination is improper since the Stern et al. preview system and the Riddell et al./Bradt et al. dispensing systems have such differing goals as to make the combination of their features by the ordinary artisan highly unlikely, without impermissible hindsight. Moreover, there is no suggestion in the references as to which features to preserve and which features to abandon to obtain the claimed invention. A few examples of these differing objectives will make it clear why the proposed combination is improper. Stern et al. describe a system, which like the present invention, is intended to allow music product consumers to "research" their purchases by actually listening to music selections by previewing a *large* number of music products. Riddell et al./Bradt et al. describe systems for dispensing a finite inventory of cassette products and enabling their proper return. Stern et al. permit preview of large number of products without regard to whether the product is available for rent/sale from the Stern et al device. Bradt et al., e.g., tie the preview mode to actual products available for dispensing from the system. Therefore, there are conflicting interests and objectives. Consequently, there is no suggestion to combine. Moreover, there is no provision in any of the cited references to enable an authorized subscriber to control playback of the music selections. Without a proper combination this objection must be withdrawn.

Applicant respectfully submits that the combination of these references is improper and traverses the rejection on these grounds.

3. Obviousness Rejection of Claims 118-120, 125-128 and 133 Over Baus in view of Stern et al.

The Examiner has rejected claims 118-120, 125-128 and 133 under 35 U.S.C. § 103 as being unpatentable over Baus in view of Stern et al. Applicant respectfully traverses this rejection, because it is submitted that the combination of Baus with Stern et al. is not suggested by the references themselves, but is instead a further example of the use of the current invention as a blueprint to locate isolated disclosures of the claimed elements in the prior art, and to then combine these references to reject the claims.

Baus merely provides written information about a product offered for sale in response to a bar code scan. The Stern et al. reference does not utilize bar codes as a means to identify the music product to be sampled. Baus differs from Stern et al in a very fundamental way. Baus provides information about a product -- Stern et al. provide actual portions of the music product itself. These are very different approaches. In addition, the concerns which drive the utility of Baus (shrinking packages due to environmental concerns and the expense of well-informed sales "counselors" reduces information about a product available to consumers) are not the same concerns which drive the utility of Stern et al.(large number of music products overwhelms most consumers, and since it is aural medium, the only way to know is to listen.) Applicant submits that it is the very fundamental differences between these driving forces which makes it improper to combine these references. This rejection should be withdrawn.

4. Obviousness Rejection of Claims 18-21, 27-29, 121-124 and 129-132 Over Riddell et al. in view of Bradt et al. and Stern et al.

The Examiner has rejected claims 18-21, 27-29, 121-124, 129-132 as unpatentable under 35 U.S.C. § 103 over Riddell et al. in view of Bradt et al. and Stern et al. as applied above (See Paragraph #5 of the October 5, 1994 Office Action) and further in view of Hughes for claims 18-21, 27-29 or Baus in view of Stern et al. (See Paragraph #6 of the October 5, 1994 Office Action) and further in view of Hughes for claims 121-124, 129-132.

Applicant respectfully traverses the rejection of claims 18-21, 27-29, 121-124 and 129-132.

With respect to the rejection based upon the combination of Riddell et al. in view of Bradt et al. and Stern et al. and then further in view of Hughes, applicant reiterates its argument above (See Paragraph # 2 above) that the combination of Riddell et al. with Bradt et al. and Stern et al. is improper. Therefore, the addition of Hughes to this improper combination is also improper. Applicant respectfully requests that this rejection be withdrawn.

Concerning the rejection of claims 121-124, 129-132, in view of Baus combined with Stern et al. and Hughes, applicant repeats and incorporates its argument that the combination of Baus and Stern et al. is improper as set forth above in Paragraph #3. Since this combination is improper, the addition of Hughes is also improper, and on this basis, the applicant respectfully requests that this rejection be withdrawn.

5. Allowable Subject Matter

The applicant acknowledges the Examiner's comment that claims 24 and 36, if rewritten in independent form would be allowable.

Applicant submits that the claims are now in condition for immediate allowance. Applicant respectfully requests the entry of a Notice of Allowance.

Respectfully submitted,
DERGOSITS & NOAH

Dated:April 5, 1995

By _____
Michael E. Dergosits
Reg. No. 31,243

Attorney Docket No. 106.02